



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 19

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

COPY MAILED

MAY 13 2002

OFFICE OF PETITIONS

In re Application of
Hans Achenbach
Application No. 09/463,851
Filed: June 5, 2000
Attorney Docket No. A32964PCT/U

DECISION ON PETITION

This is a decision on the petition filed on January 10, 2002, pursuant to 37 C.F.R. §1.137(b), to revive the above-identified application. This petition is *sua sponte* being treated as a petition to withdraw the holding of abandonment under §1.181. This decision also responds to the "Petition under §1.53(e) to Convert Improper CPA Application Filed Under 37 CFR §1.53(d) to an Application under CFR §1.53(b)."

The petition under §1.181 is **GRANTED**. ✓

The above-identified application became abandoned for failure to timely file a proper response to the non-final Office action mailed January 4, 2001. This Office action set a shortened statutory period for reply of three (3) months from the mailing date of the action, with extensions of time obtainable pursuant to 37 C.F.R. §1.136(a). On July 3, 2001, applicants replied filing a request for Continued Prosecution Application (CPA), made timely by an accompanying request for a three-month extension of time. By "Notice of Improper Request for Continued Examination (RCE)" mailed August 6, 2001, applicant was informed that the request did not meet the requirements for CPA practice as the application was filed on or after May 29, 2000. Moreover, the request was improper as a constructive RCE because it lacked the required submission under §1.114. On August 15, 2001, applicant filed an amendment, which was determined to be untimely and not entered. As no further extensions of time for reply were obtainable, the above-identified application became abandoned effective July 5, 2001. A Notice of Abandonment was mailed on September 6, 2001.

On January 10, 2002, applicants filed the instant petition, a response in the form of an RCE and amendment, and another petition for an extension of time.

Consideration of this petition is unnecessary. A review of the prosecution history of this application reveals that the application is not in fact abandoned. The reply, a CPA, filed July 3, 2001 was a proper reply to the non-final Office action mailed January 4, 2001.

37 C.F.R. §1.53(d)(1) provides, in pertinent part, that:

A continuation or divisional application (but not a

continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The prior nonprovisional application is either:

(A) A utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by § 1.51(b); or

(B) A design application that is complete as defined by § 1.51(b); or

(C) The national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371 ...

The instant application is the national stage of international application PCT/GB98/02317 filed July 31, 1998, and was in compliance with 35 U.S.C. 371 on the date of filing of the CPA, July 3, 2001.

In view thereof, it is concluded that:

The "Notice of Improper Request for Continued Examination" mailed August 6, 2001 was mailed in error and is hereby **VACATED**.

The holding of abandoned is hereby **WITHDRAWN**.

Since consideration of the petition under §1.137(b) is unnecessary for the reasons cited, the petition fee has been refunded to Deposit Account No. 02-4377, as authorized.

The replies filed with the petition under §1.137(b), an amendment and an RCE, will not be entered.

Because no extension of time for response can be obtained outside of the maximum statutory period for reply, which in this case ended July 4, 2001, the request for a three-month extension submitted on petition will not be entered. The extension fee has been refunded to Deposit Account No. 02-4377, as authorized.

Re: Petition to Convert

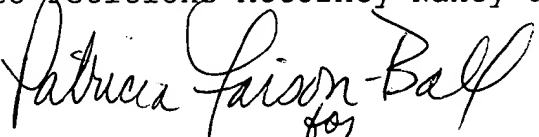
On September 19, 2001, applicant filed a "Petition Under 37 CFR 1.53(e) to Convert Improper CPA Application..." in direct response to the "Notice of Improper Request for Continued Examination, which has been determined to have been mailed in error." See p. 3 of the petition. Prior to consideration of the instant petition, on April 14, 2002, the Group Director of Technology Center 1600 issued a decision dismissing this petition under §1.53. A review of this decision reveals that the petition was improperly treated as one to convert the application to a provisional under §1.53(c).

Accordingly, the decision mailed April 9, 2002 is hereby **VACATED**.

As the CPA filed July 3, 2001 is no longer considered improper, the petition under §1.53(e) is **DISMISSED AS MOOT**. Given the basis for dismissing this petition, the petition fee has been refunded to Deposit Account No. 02-4377, as authorized.

The application file is being forwarded to Technology Center 1600 for consideration of the CPA filed July 3, 2001, the preliminary amendment filed August 15, 2001.

Telephone inquiries concerning this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.


for
Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy